

MAC address is not available responsive to a determination that said selected MAC address is in-use by another client.

REMARKS

In an Office Action dated 8 September 2005, the Examiner rejects claims 1-44 (all pending claims). In response to the Office Action, Applicants amend claims 1- 15,20-21, 23-26, 31-32, and 34-44. Applicants also respectfully traverse the rejections. Claims 1-44 remain in the application. In light of the amendments and the following arguments Applicants respectfully request that this application be allowed.

Applicants have amended the claims to more precisely claim the subject matter that Applicants regard as this invention. No new matter is entered by these amendments. In the Office Action, the Examiner rejects claim 1 under 35 U.S.C. §102 as being anticipated by U.S. Patent Application Publication 2004/0249975 A1 on behalf of

Tuck et al. (Tuck). To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The **test for anticipation** is symmetrical to the test for infringement and has been stated as: “That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). The Examiner has failed to provide a reference that teaches all the elements of claim 1.

Amended claim 1 recites a method performed by a client system in a network to receive a MAC address. In this case the fact that the preamble states that the method is performed by a client computer must be considered when reading the claim. Amended claim 1 recites that the client selects a MAC address and transmits a MAC address request frame for the address. These elements are not taught in Tuck. Instead, Tuck teaches a system in which a server receives MAC messages and assigns an address to a client based upon information received from the client. Thus, a client in the Tuck reference does not select an address and determine that the address is available because a server insures that the MAC address is available before the MAC address is assigned to a client. Thus, a client in Tuck does not have to perform a contention method of receiving an address as recited in amended claim 1. For this reason, Applicants respectfully request that the rejection of claim 1 be removed and amended claim 1 be allowed.

Amended claims 2-8 depend from amended claim 1. Thus, amended claims 2-8 are allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 2-8 be removed and amended claims 2-8 be allowed.

Amended claim 12 recites a client system that performs the method of claim 1. Thus, claim 12 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 12 and allow amended claim 12.

Amended claims 13-19 depend from amended claim 12. Thus, amended claims 13-19 are allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the rejections of claims 13-19 be removed and amended claims 13-19 be allowed.

Amended claim 23 recites a client system that performs the method of claim 1. Thus, amended claim 23 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 23 and allow amended claim 23.

Claims 24-30 depend from amended claim 23. Thus, amended claims 24-30 are allowable for at least the same reasons as amended claim 23. Therefore, Applicants respectfully request that the rejections of claims 24-30 be removed and amended claims 24-30 be allowed.

Amended claim 34 recites client system software that performs the method of claim 1. Thus, amended claim 34 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 34 and allow amended claim 34.

Amended claims 35-41 depend from amended claim 34. Thus, amended claims 35-41 are allowable for at least the same reasons as amended claim 34. Therefore, Applicants respectfully request that the rejections of claims 35-41 be removed and amended claims 35-41 be allowed.

The Examiner also rejects claim 2 under 35 U.S.C. §102 as being anticipated by Tuck. To anticipate a claim under 35 U.S.C. § 102, a single source must contain all of the elements of the claim. *Lewmar Marine Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 U.S.P.Q.2d 1766, 1768 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988). Moreover, the single source must disclose all of the claimed elements “arranged as in the claim.” *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 716, 223 U.S.P.Q. 1264, 1271 (Fed. Cir. 1984). The **test for anticipation** is symmetrical to the test for infringement and has been stated as: “That which would literally infringe [a claim] if later in time anticipates if earlier than the date of invention.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989); *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. 1931, 1938 (Fed. Cir. 1983). The Examiner has failed to provide a reference that teaches all the elements of claim 9.

Amended claim 9 recites a server that receives a request to use an address from a client, determines if the address is in use and sends a response indicating that the address is free for the client to use. Tuck does not teach these limitations. Instead, Tuck teaches a system in which the server selects an address for a client node and transmits the address to the client. Thus, there is no need in Tuck for a server that confirms an address as recited in amended claim 9. Thus, Tuck does not teach amended claim 9. Therefore, Applicants respectfully request that the rejection of claim 9 be removed and amended claim 9 be allowed.

Amended claims 10-11 depend from amended claim 9. Thus, amended claims 10-11 are allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the rejections of claims 10-11 be removed and amended claims 10-11 be allowed.

Amended claim 20 recites a client system that performs the method of claim 9. Thus, amended claim 20 is allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 20 and allow amended claim 20.

Amended claims 21-22 depend from amended claim 20. Thus, amended claims 21-22 are allowable for at least the same reasons as amended claim 20. Therefore, Applicants respectfully request that the rejections of claims 21-22 be removed and amended claims 21-22 be allowed.

Amended claim 31 recites a client system that performs the method of claim 9. Thus, amended claim 31 is allowable for at least the same reasons as amended claim 9. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 31 and allow amended claim 31.

Claim 33 and amended claims 32-33 depend from amended claim 31. Thus, amended claims 32-33 are allowable for at least the same reasons as amended claim 31. Therefore, Applicants respectfully request that the rejections of claims 31-33 be removed and amended claims 31-33 be allowed.

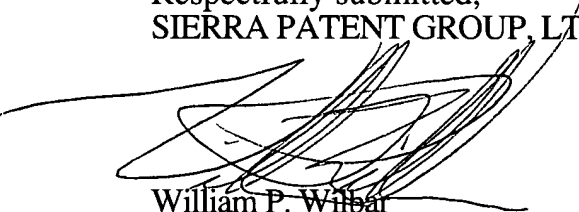
Amended claim 42 recites client system software that performs the method of claim 9. Thus, amended claim 42 is allowable for at least the same reasons as amended claim 1. Therefore, Applicants respectfully request that the Examiner remove the rejection of claim 42 and allow amended claim 42.

Amended claims 43-44 depend from amended claim 42. Thus, amended claims 43-44 are allowable for at least the same reasons as amended claim 42. Therefore, Applicants respectfully request that the rejections of claims 43-44 be removed and amended claims 43-44 be allowed.

If the Examiner has any questions regarding this response or the application in general, the Examiner is invited to telephone the undersigned at 775-586-9500.

Respectfully submitted,
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Dated: November 4, 2005



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